

REMARKS

Claims 1-22 are pending in this application. No claims have been cancelled or added. Claims 1 and 13 have been amended to require that a physician transmit the prescription from the first computer and that the server is remote from the first computer. Support for these amendments may be found in the specification in paragraphs [0025] and [0026] and FIG. 1. Accordingly, no new subject matter is believed to have been added by these amendments.

It is to be understood that the added limitations of claims 1 and 13 were introduced for the purpose of clarifying the communicative entities and relationships therebetween and do not change the scope of the claims. As further discussed below, the arguments made with respect to the amended claims are equally applicable to the original claims. In other words the original claims define over the prior art.

Claims 1-22 still remain in this application.

Claim Objections

Claim 8 stands objected to for informalities. Applicant has amended claim 8 to end with a period. Reconsideration of this objection is respectfully requested.

35 U.S.C. § 101 Rejections

Claims 13-16 stand rejected under U.S.C. § 101 for being directed to non-statutory subject matter. These claims are directed to a method for issuing a prescription. It is well known and established that business method claims are considered patentable subject matter. In the precedent case of *State Street Bank & Trust v. Signature Financial Group* (149 F.3d 1368 (Fed. Cir. 1998)), the court rejected the theory that a method of doing business is an excluded category of invention and reiterated that a business method patent may be granted on the same basis as any other invention as long as there is “a useful, concrete and tangible result.” The result of the invention in the *State Street* case was the price of a share of stock, which the court deemed to be a useful, concrete and tangible result. In the present invention, the method of soliciting bids for a prescription and then selecting any one of those bids for purposes of filling the prescription fulfills the statutory subject matter criteria set forth in the aforementioned case law. The concrete and tangible result is having a prescription filled based upon favorable criteria of interest to the patient (cheapest price,

geographic proximity, etc.). Accordingly, the claimed subject matter is patentable subject matter.

Of note, the *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility* published in the Official Gazette on November 22, 2005 instruct examiners that:

[i]n determining whether a claim provides a practical application that produces a useful, tangible, and concrete result, the examiner should consider and weigh the following factors:

...

(3) "CONCRETE RESULT"

Another consideration is whether the invention produces a "concrete" result. Usually, this question arises when a result cannot be assured. In other words, *the process must have a result that can be substantially repeatable* (emphasis added) or the process must substantially produce the same result again. *In re Swartz*, 232 F.3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000) (where asserted result produced by the claimed invention is "irreproducible" claim should be rejected under section 101). The opposite of "concrete" is unrepeatable or unpredictable. Resolving this question is dependent on the level of skill in the art. For example, if the claimed invention is for a process which requires a particular skill, to determine whether that process is substantially repeatable will necessarily require a determination of the level of skill of the ordinary artisan in that field. An appropriate rejection under 35 U.S.C. Sec. 101 should be accompanied by a lack of enablement rejection under 35 U.S.C. Sec. 112, paragraph 1, where the invention cannot operate as intended without undue experimentation. See *infra*.

As discussed in the *Interim Guidelines*, the opposite of "concrete" is unrepeatable or unpredictable. It has been indicated above that the concrete and tangible result is the ability to offer a favorable criteria of interest to the patient. The ability to obtain such favorable criteria is repeatable and, therefore, concrete, in accordance with the *Interim Guidelines*. If the Examiner intends to maintain the § 101 rejection, Applicant requests that the Examiner issue a lack of enablement rejection under § 112, paragraph 1, to specifically show where the invention cannot operate as intended without undue experimentation, as is required by the *Interim Guidelines*.

In any case, the Examiner's § 101 rejection cannot be maintained as a matter of precedential Federal Circuit Law, which requires that "a useful, concrete, and tangible result" be obtained, which is the case with the invention of claims 13-16. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 101 rejection.

35 U.S.C. §102 Rejections

Independent claims 1 and 13 stand rejected under 35 U.S.C. § 102(b) for anticipation by U.S. Patent Application Publication No. 2002/0065758 to Henley.

The Henley publication generally discloses a system for negotiating professional medical services and associated fees through online bidding. However, the Henley publication does not disclose all of the elements of the claimed invention as set forth in claims 1 and 13, namely, a prescription bidding system in combination with the aspect of allowing a physician to prescribe and transmit a patient's prescription to a database. The first two elements of claims 1 and 13 require that a prescription is to be sent from a first computer (i.e., physician computer) to a server. Based upon the rejection of these elements of the claims, it appears that the Examiner equates the client-provider computer system (10) (shown in FIG. 1 of the Henley publication) to the first computer (14) (shown in FIG. 1 of the present invention; physician computer). It is the client-provider computer system (10) that "enables a service provider to... automatically compute an offering price" (See paragraph [0063] of the Henley publication). The claimed first computer does not function as a bidding computer and the client-provider computer system (10) cannot transmit a prescription. For the benefit of the Examiner, Applicant further clarifies the communicative entities and relationships therebetween of the present invention. Specifically, Applicant has amended claims 1 and 13 to require that a physician transmit the prescription from the first computer and that the server is remote from the first computer.

The Examiner offers paragraphs [0032] and [0040] of the Henley publication as disclosing how the server is configured to receive a prescription from the first computer. Based upon these paragraphs, it appears that the Examiner equates the buyer's computer (under control of the buyer of the prescription medicine) to the second computer (16) (shown in FIG. 1 of the present invention; patient computer). However, the second computer (16) does not transmit a prescription because the prescription is transmitted by the first computer (under control of the physician issuing the prescription). In any case, the Henley publication fails to disclose *any* communicative entity that transmits a prescription to the server. Paragraph [0040] of the Henley publication discloses how a "qualified buyer of prescription medicine and non-prescription medicine [can] post a proposal to buy the medicine at a price that he/she is willing to pay for the medicine via a public database accessible to sellers of the medicine and to receive and communicate offers to sell the medicine at the seller's proposed purchase price." Thus, the server in the Henley publication may be configured to store *information concerning the types of prescription medicine* that are available. There is no disclosure with respect to a *prescription* that is stored, transmitted, or received in connection

with the system of the Henley publication. Furthermore, as discussed above, the qualified buyer accessing the servers transmits proposals to purchase the medicine at a set cost. A patient's posted request for a type of drug that they are seeking cannot be equated to a prescription. Therefore, the limitations of claims 1 and 13 relating to transmitting a prescription from a computer to a server, in the context of the other limitations, is not disclosed, taught or suggested by the Henley publication. It is to be understood that the aforementioned arguments with respect to the prescription transmission and storage aspects apply to the prior art irrespective of whether the clarifying limitations are added to the claims or not.

For the foregoing reasons, Applicant believes that the subject matter of original and now amended independent claims 1 and 13 is not anticipated by the Henley publication. Claims 2-12 and 14-16 depend from and add further limitations to independent claims 1 and 13, respectively, and are believed to be patentable for the reasons discussed hereinabove in connection with independent claims 1 and 13. Accordingly, Applicant deems the obviousness rejections relating to these dependent claims as moot. Reconsideration of the rejections of claims 1-12 and 13-16 is respectfully requested.

35 U.S.C. § 103 Rejections

Independent claim 17 stands rejected under 35 U.S.C. § 103(a) for obviousness over the Henley publication in view of U.S. Patent Application Publication No. 2001/0039503 to Chan et al. and further in view of U.S. Patent Application Publication No. 2002/0010679 to Felsher.

The Examiner asserts that although the portable storage medium limitations are not disclosed in the Henley publication, it would be obvious to combine the teachings of the Chan et al. and Felsher publications (that the Examiner argues disclose the portable storage medium limitations) with the Henley publication to obtain the overall claimed invention.

The limitations of claim 17 are either being construed out of context in relation to each other or are not even discussed in the prior art cited by the Examiner. It appears to the Applicant that the Examiner is citing the Chan et al. publication merely for the purpose of showing exemplary storage mediums for containing the software responsible for the operation of the system discussed in the Chan et al. publication (See paragraph [0083]).

Application No.: 10/773,912

Paper Dated: May 14, 2007

In Reply to: USPTO Office Action dated January 12, 2007

Attorney Docket No.: 4461-040040

Furthermore, the Examiner is pointing out how graphical user interfaces may have various access levels attributed to them (See paragraph [0065]).

In any case, claim 17 requires that not only a “prescription entry web page” be transmitted from the server to the computer when a digital certificate is authenticated (which the Examiner argues is disclosed in the et al. publication), but *also* that it is the execution of the application on the portable storage medium upon interfacing of the portable storage medium with a computer that causes the claimed series of events to occur. This latter claimed aspect is neither disclosed in the Chan et al. publication nor the Felsher publication.

The Examiner states that paragraph [0245] of the Felsher publication discloses “an application residing on the portable storage medium wherein the application is configured to execute once the portable storage medium interfaces with the computer, further wherein the application is configured to transmit a digital certificate.” Applicant fails to see where these limitations of claim 17 are discussed in the Felsher publication. Applicant’s understanding of the disclosure of paragraph [0245] is that certification authorization may be responsible for maintaining authentication keys for the purpose of granting requested future access to a database/record/file by authorized personnel. Neither the disclosure of paragraph [0245] nor any other part of the Felsher publication discloses the aforementioned limitation of claim 17. Assuming, *arguendo*, that a portable storage medium having a digital certificate is impliedly disclosed in the Felsher publication, there is no disclosure with respect to the “auto-run” aspect of the application residing on the portable storage medium.

For the foregoing reasons, Applicant believes that the subject matter of independent claim 17 is not rendered obvious by the Henley publication in view of the Chan et al. publication and further in view of the Felsher publication. Claims 18-22 depend from and add further limitations to independent claim 17 and are believed to be patentable for the reasons discussed hereinabove in connection with independent claim 17. Reconsideration of the rejections of claims 17-22 is respectfully requested.

Application No.: 10/773,912

Paper Dated: May 14, 2007

In Reply to: USPTO Office Action dated January 12, 2007

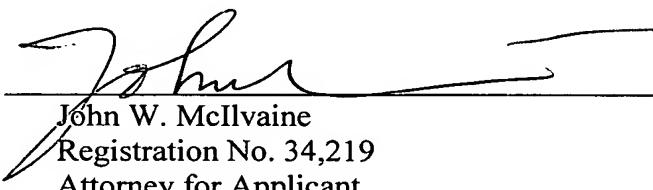
Attorney Docket No.: 4461-040040

CONCLUSION

Based on the foregoing amendments and remarks, reconsideration of the rejections and allowance of pending claims 1-22 are respectfully requested.

Respectfully submitted,

THE WEBB LAW FIRM

By 

John W. McIlvaine

Registration No. 34,219

Attorney for Applicant

700 Koppers Building

436 Seventh Avenue

Pittsburgh, PA 15219

Telephone: 412-471-8815

Facsimile: 412-471-4094

E-mail: webblaw@webblaw.com